

Application Serial No.: 09/879,823

Attorney Docket No. 24122-303-408

In Response to Final Office Action mailed October 8, 2003

REMARKS

In response to the Final Office Action mailed October 8, 2003 (Paper No. 15), no claims have been amended or cancelled. Claim 62 has been newly added. Therefore, claims 47-62 are pending. In view of the following comments, withdrawal of all the claim rejections is respectfully requested.

Information Disclosure Statement (I.D.S.)

Applicants are submitting herewith an Information Disclosure Statement ("IDS"). Applicants respectfully request that the Examiner consider the cited references and provide a signed copy of the Form PTO-1449 for this submission with the next Office Action.

Improper Final Rejection

Applicants submit that the Examiner has improperly designated the Office Action mailed October 8, 2003 as "FINAL." In the First Office Action (Paper No. 7, mailed February 24, 2003), the Examiner presented rejections under 35 U.S.C. §112, first paragraph, alleging lack of support for two claim elements. In the Final Office Action mailed October 8, 2003 (Paper No. 15), however, the Examiner presented new rejections under 35 U.S.C. §112, first paragraph, alleging lack of support for claim elements which were present when the Examiner issued the First Office Action. Applicants note MPEP §707.07(g) which recites, in part:

Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references.

For *at least* the reason that the Examiner introduced new rejections under 35 U.S.C. §112, first paragraph, for the first time in the "Final" Office Action, Applicants submit that the Office Action mailed October 8, 2003 was improperly made "FINAL." However, to ensure that this Response will be entered and considered on the merits, Applicants have filed a Request for Continued Examination (RCE) herewith.

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Rejections Under 35 U.S.C. § 112, First Paragraph

Independent claims 47, 52, 57, & 61 stand rejected under 35 U.S.C. §112, first paragraph, for allegedly containing subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See Final Office Action, pg. 2, ¶3.

1. Claims 47, 52, 57

With regard to claims 47, 52, & 57, the Examiner alleges that the Specification fails to provide support for the recited claim elements of “*wherein each coupon may be used a pre-determined number of times,*” and “*monitoring redemption of the one or more coupons such that each coupon may be used a predetermined number of times.*” Applicants traverse this rejection.

Applicants again draw the Examiner’s attention to the Interview Summary (Paper No. 8). As discussed and agreed during the personal interview on June 3, 2003, and further acknowledged in the Interview Summary, the Specification supports setting the predetermined number of times to one. Additionally, as acknowledged in the Interview Summary, “*the 35 U.S.C. 112 rejections will be withdrawn upon receipt of a response.*”

The Examiner alleges, in the Final Office Action at pg. 4, ¶4, that “*...the Interview summary dated 6/3/03 stated that the addition of a wherein clause at the end of the claim specifying that the predetermined number of times was one would make the claim supported by the specification.*” This is incorrect. The Interview Summary states “*...Examiner recommended the addition of a “wherein” clause at the end of the claim, specifying that the predetermined number of times was one. Since the Applicant had support for a subset of the above feature, the 35 U.S.C. 112 rejections will be withdrawn upon receipt of a response.*” **Emphasis Added.**

With regard to the Examiner’s argument that the term “predetermined” fails to appear in the Specification (in the context of the claim elements recited above), Applicants note MPEP §2163.02 which recites, in part:

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The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.

Accordingly, Applicants maintain that the Specification supports the recited claim elements.

2. Claims 47, 52, 57, 61

With regard to claims 47, 52, 57, & 61, the Examiner alleges that the Specification fails to provide support for a “*target audience*.” Applicants traverse this rejection.

Support for this claim element may be found in *at least* the following exemplary citations to the Specification and/or drawing figures: pg. 17, lines 7-26; and pg. 29, lines 14+. Accordingly, withdrawal of this rejection is earnestly sought.

3. Claims 47, 52, 57, 61

With regard to claims 47, 52, 57, & 61, the Examiner further alleges that the Specification fails to provide support for “*preferences*” and “*preferences of respective users stored in the respective user’s devices*.” Applicants traverse this rejection.

Support for these claim elements may be found in *at least* the following exemplary citations to the Specification and/or drawing figures: FIG. 2; pg. 16, lines 5-10; pg. 20, lines 16-20; pg. 21, line 4; and pg. 24, lines 26+. Accordingly, withdrawal of this rejection is earnestly sought.

4. Claims 47, 52, 57, 61

With regard to claims 47, 52, 57, & 61, the Examiner further alleges that the Specification fails to provide support for a “*user’s device*.” Applicants traverse this rejection.

Applicants note that the actual claim element recited is “*devices coupled to a network*.” Regardless, support for this claim element may be found in *at least* the following exemplary

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citations to the Specification and/or drawing figures: FIGS. 1-2; pg. 15, lines 27+; pg. 16, lines 5-10; and pg. 20, lines 8-22. Accordingly, withdrawal of this rejection is earnestly sought.

5. Claims 47, 52, 57, 61

With regard to claims 47, 52, 57, & 61, the Examiner alleges that the Specification fails to provide support for a “*subset of users*.” Applicants traverse this rejection.

Support for this claim element may be found in *at least* the following exemplary citation to the Specification and/or drawing figures: pg. 29, lines 14-27. Accordingly, withdrawal of this rejection is earnestly sought.

Interference

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action. As such, Applicants request that an interference be declared between the above-identified application, and U.S. Patent No. 6,075,971 to Williams *et al*.

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CONCLUSION

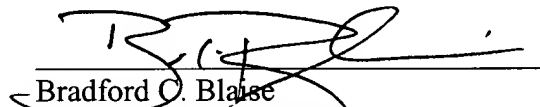
Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

Date: April 5, 2004

By:


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